

Application No. 09/858,091  
Amendment dated October 8, 2004  
Reply to Office Action of March 8, 2005

REMARKS

I. Summary of Office Action

Claim 1 and subsequent claims have been rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 15 have been rejected under 35 U.S.C. § 101 for lacking explicit technological features.

Claims 1-56 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginsberg U.S. Patent No. 6,754,639 ("Ginsberg").

II. Summary of Reply to Office Action

Claims 1, 15, 29, 34, 40-43, 48 and 54-56 have been amended to more particularly point out and distinctly claim the invention. No new matter has been added by these amendments and the claims are fully supported and justified by the application as originally filed. Claims 57 and 58 have been added to more particularly point out and distinctly claim the invention.

The rejections under 35 U.S.C. § 101, 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 103(a), based on Ginsberg, are respectfully traversed.

III. Reply to Rejection under 35 U.S.C. § 112

Claim 1 and subsequent claims have been rejected under 35 U.S.C. § 112, second paragraph for failing to

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particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Office Action rejected the claims because "the term 'substantially' is indefinite" (Office Action, page 2). Applicant respectfully disagrees with the Office Action's conclusion, but in the interest of advancing prosecution applicant has amended the claims to remove the phrase "substantially simultaneously."

Accordingly, applicant submits that the rejection of claim 1 and subsequent claims under U.S.C. § 112, second paragraph should be withdrawn.

IV. Reply to Rejection under 35 U.S.C. § 101

Claims 1 and 15 have been rejected under 35 U.S.C. § 101 for lacking explicit technological features (see Office Action, page 2). Applicant respectfully traverses this rejection.

Applicant has amended claims 1 and 15 in order to provide explicit technological features. The support for these amendments can be found in the specification as originally filed at, e.g., page 12, line 32 to page 13, line 21 and FIG. 8.

Accordingly, applicants submit that claims 1 and 15 have technological features, and for at least this reason, the rejection under 35 U.S.C. § 101 should be withdrawn.

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V. Reply to Rejection under 35 U.S.C. § 103(a)

Claims 1-56 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginsberg.

Applicant's independent claims 1, 15, 29, 43, 57 and 58 relate to shifting bids or offers in a trading system. Common to the independent claims is that a trading server is operated to communicate with a plurality of user computers. At least one of the plurality of user computers or the trading server is adapted to receive a selection of a plurality of bids or offers. In claims 1, 29 and 57, prices of the selection of the plurality of bids or offers are shifted in response to the selection. In claims 15, 43 and 58, sizes of the selection of the plurality of bids or offers are shifted in response to the selection.

The Office Action contends that independent claims 1, 15, 29 and 43 are obvious over Ginsberg. Applicant respectfully disagrees. Ginsberg is directed to a data processing system that receives transactional data related to fixed income securities (see Ginsberg, abstract). Using this data, indices for use in accurately gauging interest rate profiles are determined in real time (see Ginsberg, column 1, lines 14-21). As pointed out in the Office Action, Ginsberg discloses comparing bid prices and ask prices of different securities on the market. These comparisons illustrate possible shifts in market conditions and are used to determine which data, from that being accumulated, is reliable. (See

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Office Action, page 3; see also Ginsberg, column 6, line 61 to column 7, line 3).

The Office Action acknowledges, though, that Ginsberg does not disclose applicant's feature of shifting prices of the selection of the plurality of bids or offers, nor does it disclose applicant's feature of shifting sizes of the selection of the plurality of bids or offers\* (see Office Action, page 3). Applicant agrees and submits that while applicant's claims may generally implicate the subject matter of Ginsberg, applicant's approach patentably improves upon Ginsberg. As noted above, in Ginsberg, the shifts for bid prices and ask prices reflect market conditions that are being monitored to collect data. Applicant's claims, however, require that the prices or the sizes of the selection of the plurality of bids or offers is shifted in response to the selection. Therefore, applicant's required claim feature reflects that the shifting is an active step being taken on the part of the trading system.

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\* The Office Action explicitly acknowledges only that Ginsberg does not disclose applicant's feature found in claims 1 and 29 of "shifting prices." The Office Action does not explicitly acknowledge that Ginsberg does not disclose applicant's feature found in claims 15 and 43 of "shifting sizes." However, the Office Action does explicitly substitute "size" for "price" in providing its reasoning elsewhere. (See Office Action, page 3 ("For claims 16-19, substitute "size" for "price" and refer to reasoning under 2-5 respectively.)) For the sake of advancing prosecution, applicant has assumed that the Office Action intended to acknowledge that the lack of disclosure applies to both shifting prices and shifting sizes.

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In addition, the Office Action takes Official Notice that the feature of shifting prices and shifting sizes is old and well known in the art. Applicant respectfully submits that the Official Notice is not justified. The Office Action may only take Official Notice of facts outside of the record which are "capable of instant and unquestionable demonstration as being 'well known' in the art" (MPEP § 2144.03). Applicant also respectfully submits that the absence from the prior art of record showing or suggesting applicant's claimed approach belies the Office Action's assertion of Official Notice. If the subsequent Office Action maintains this rejection, applicant respectfully requests that a reference be provided in support of the Official Notice used in rejecting claims 1, 15, 29 and 43, as is applicant's right under MPEP § 2144.03.

Accordingly, for at least the foregoing reasons, applicant's independent claims 1, 15, 29, 43, 57 and 58 are allowable.

VI. Dependent Claims 2-14, 16-28, 30-42 and 44-56

Claims 2-14 are dependent from claim 1 and are allowable at least because claim 1 is allowable. Claims 16-28 are dependent from claim 15 and are allowable at least because claim 15 is allowable. Claims 30-42 are dependent from claim 29 and are allowable at least because claim 29 is allowable. Claims 44-56 are dependent from claim 43 and are allowable at least because claim 43 is allowable.

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VII. Conclusion

Accordingly, this application is in condition for allowance. Reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,



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